

9/18/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Asics Corporation**

Serial No. 74/**629,013**

Michael Zall of Asics Tiger Corporation for applicant.

Patricia Horrall, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Quinn, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Asics Corporation has filed an intent-to-use
application to register the mark AIR BORN for a "snow
board".¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the
ground that applicant's mark, if applied to its identified
goods, would so resemble the previously registered mark

¹ Ser. No. 74/629,013, filed February 2, 1995.

AIRBORNE for "roller skates"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont³ factors.

Turning first to a consideration of the respective marks, applicant's mark AIR BORN and the registered mark AIRBORNE are identical in pronunciation, and are extremely similar in connotation and appearance. Specifically, the marks connote speed as the person either snow boards or roller skates; and the marks connote the snow board or the roller skate itself going into the air (or airborne) as the rider either glides over the crest of a mound of snow or the roller skater lifts off the ground temporarily.

Regarding the appearance of the two marks, it is true that the marks are not identical. However, purchasers are unlikely to notice or remember the slight differences between the marks, namely, the letter "E" which is present only in the registered mark, and that applicant's mark is two words while the registered mark is one word. See Puma-

² Reg. No. 2,004,782, issued October 1, 1996. The claimed dates of first use and first use in commerce are July 1994.

³ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255, 259 (TTAB 1980). Thus, the commercial impression created by the marks, AIR BORN and AIRBORNE, is essentially the same.

Applicant argues that the words AIR and BORN have been extensively used by third parties, and therefore, there are many similar marks in use. Applicant submitted no evidence on this point, but instead requested that the Board take judicial notice of the fact that the words AIR and BORN "are extremely commonly used" and that "AIR is commonly used in Federal Registered Trademarks". (See pages 4-5 of applicant's brief). Applicant's request for judicial notice is denied. See Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290, 1293 (TTAB 1986); and Cities Service Co. v. WMF of America, Inc., 199 USPQ 493, footnote 4 (TTAB 1978). See also, Fed. R. Evid. 201, and TBMP §712.01. In any event, even if the words AIR and BORN (or BORNE) have been extensively used in third-party marks, there is no showing that the combination thereof has been widely used.

Turning to a consideration of the respective goods, applicant's goods are snow boards, and the registered goods are roller skates. Although the goods involved in this appeal are obviously specifically different, they are

nonetheless both sporting goods which can be used by the same class of purchasers. It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992).

The Examining Attorney has made of record copies of six third-party registrations (three are based on use in commerce) and five third-party applications, each of which includes within the identification of goods, *inter alia*, both roller skates and snow boards. The evidence is offered to show that both items of goods are likely to be sold by a single entity under a single mark.

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have

some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Applicant argues that snow boards are "devices used in the very highly specialized winter sport of skiing, i.e., snowboarding", and that they are sold through specialty ski shops. Applicant also argues that the purchasers of the involved goods are "careful, sophisticated", and that the goods are "relatively expensive". Even accepting these statements, the same person may engage in snowboarding as well as roller skating; and upon seeing the substantially similar marks AIR BORN and AIRBORNE, may believe the goods emanate from or are otherwise sponsored by or affiliated with the same source.

In its appeal brief, applicant argues with respect to the du Pont factor concerning the nature and extent of any actual confusion that: "Both marks are presently being used. There has been no evidence of actual confusion." The application is based on intent to use, however, and there is no evidence as to the length of time applicant has been using its mark (presumably use commenced recently), nor is there any evidence as to the amount and extent of any

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sales.⁴ Therefore, we cannot assess the impact of this factor and cannot find it weighs in applicant's favor. In any event, the test is likelihood of confusion, not actual confusion.

Decision: The refusal under Section 2(d) is affirmed.

T. J. Quinn

G. D. Hohein

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

⁴ In addressing another du Pont factor, namely, the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion, applicant stated: "There has been concurrent use, however, the length of time of such use and conditions of such use are unknown."